

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-6, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) over the patent to Price-Francis in view of the patents to Yu and Funk.

Claims 7 and 10 are rejected under 35 U.S.C. 103(a) over the patents to Price-Francis, Yu and Funk and further in view of the patent to Yap.

Also, the drawings are objected to and the claims are rejected under 35 U.S.C. 112.

In connection with the Examiner's objections and rejections, applicant has canceled the original claims and submitted a new set of claims 12-19. It is respectfully submitted that the new features of the present invention which are now defined in claims 12-19 are not disclosed in the references and can not be derived from them as a matter of obviousness.

Before the analysis of the prior art, it is believed to be advisable to explain in detail the new features of the present invention which are now defined in the claims.

Claims 12 and 14 define a personal data carrier and a passport, correspondingly, comprising the following elements.

a facial image of an individual;

a fingerprint of the same individual;

a code which is separate from and does not have features of said facial image and said fingerprint,

such that said facial image, said fingerprint and said code can be stored in a secured database,

and thereafter an official to whom the personal data carrier/passport is presented can take a fingerprint of a presenter, send the taken fingerprint and said code to the database, and obtain from the database a conclusion whether the taken fingerprint correspond to the fingerprint stored in the database.

Claims 12 and 14 specifically define that a personal data carrier or a passport have a facial image of an individual, a fingerprint of the same

individual, and a code which has nothing to do with the fingerprint and the facial image, and in particular is separate and different from the fingerprint and the facial image.

As a result, in order to determine the identity of a personal data carrier/passport presenter, it is sufficient to transmit to a secured database only the code, and in the database, based on the received code, the facial image and the fingerprint are found, so that the received fingerprint is compared with the stored fingerprint whether they match or mismatch, while the facial image is transmitted to the official to whom the personal data carrier/passport is presented.

Turning now to the references, and particularly to the patent to Price-Francis, it can be seen that in this reference data representing the characteristic features of a plurality of fingerprints are coded and stored on the card by scanning designated fingers of the person. This has nothing to do with the present invention as now defined in claims 12 and 14 and is significantly different from it. In the present invention the code on the personal data carrier/passport has nothing to do with the fingerprints, and it is a separate and different code which does not include any features of the fingerprints. Such a code does not necessary need scanning of the

fingerprints as in this reference, to produce a special code, and therefore the personal data carrier/passport can be made in a simpler manner.

The other references also do not teach these features of the present invention . It is therefore respectfully submitted that claims 12 and 14 should be considered as patentably distinguishing over the art and should be allowed.

Claim 13 defines that the facial image and the fingerprint are located on opposite sides of the personal data carrier, while claim 15 defines that the facial image and the fingerprint are located on different pages of the passport. These features are very important. When a personal data carrier and the passport are formed as defined in claims 13 and 15, the facial image and the fingerprint are not located on the same side of the substrate of the personal data carrier or on the same page of the passport. As a result, the facial image and the fingerprint are independent from one another, each of them can occupy the whole side or the whole page so as to improve the visibility, recognizability and scanning of the facial image and of the fingerprint separately and independently from one another.

The features of claims 13 and 15 are not disclosed in the

references and can not be derived from them as a matter of obviousness, and therefore these claims should be considered as patentably distinguishing over the art not only because they depend on the presumably allowable claims 12 and 14 correspondingly, but also because they contain the patentable subject matter per se.

Claims 15 and 16 disclose a system for and a method of verifying an identity of an individual which includes a passport as defined in claim 14, a secure database which stores the facial image, the fingerprint, and the code from the real originally made passport, and based on the presented code by a passport presenter sends to the official to whom the passport is presented the facial image stored in the database and the information whether the fingerprint taken by the official to whom the passport is presented match or mismatch with the fingerprint stored in the database, and also include a scanner/display device in which the passport are introduced, the facial image, the fingerprint, and the code are scanned and transmitted to the database for the steps specified herein above.

The features of these claims are not disclosed in the references and can not be derived from them as a matter of obviousness, and therefore these claims also patentably distinguish the preent invention

from the prior art.

Claims 17 and 19 define that the system and the method operate with such a passport on which the facial image and the fingerprint are located on separate pages of the passport. This is very convenient for the reasons which were first of all explained with respect to claims 13 and 15.

The references do not teach the new features of the invention as defined in the claims. In order to arrive at the features of the claims, they have to be fundamentally modified. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, the present invention as defined in the claims provides for

highly advantageous results which can not be accomplished by the solutions disclosed in the prior art.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that all claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,

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08/24/03

Extension Request

It is respectfully requested to
extend the term for response
by 1 month and close to
26-0085.

